



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,054	03/28/2001	Adam R. Schran	10397-1U1	3079

570 7590 07/14/2005

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,054

Applicant(s)

SCHRAN ET AL.

Examiner

Etienne P LeRoux

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims Status

Claims 1-30 are pending. Claims 1-30 are rejected as detailed below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,826,242 to Montulli in view of Pub No US 2004/0230820 to Hui Hsu et al (hereafter Hui Hsu).

Claims 1 and 16:

Montulli discloses:

Art Unit: 2161

- a) receiving at a server, a request from a subscriber to send a file to the client machine [Fig 1A and col 4, lines 38-52]
- b) downloading the file to the client machine [col 4, lines 38-52]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [col 9, lines 52-62].

Montulli discloses a file such as a list of cookie file sources located at the client computer but is silent regarding a list of cookie file sources at the server. Hui Hsu discloses a list of cookie file sources at the server [database unit 32, Fig 1, paragraph 58, paragraph 89]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli to include a list of cookie file sources at the server for the purpose of controlling what cookies can be passed to the client [paragraph 57]. The skilled artisan would have been motivated to improve the invention of Montulli per the above such that undesirable cookies are not stored at the client computer [paragraph 57]. Also, the combination would have rendered a system that would allow cookies to be updated routinely without having to “handshake” with the client – a very desirable result in an environment where IP addresses change continuously.

Claims 1, 3, 6, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,282,709 to Reha et al (hereafter Reha) and further in view of Pub No US 2004/0230820 to Hui Hsu et al (hereafter Hui Hsu).

Claims 1 and 16:

Reha discloses:

Art Unit: 2161

- a) receiving at a server, a request from a subscriber to send a file to the client machine [col 2, lines 1-8]
- b) downloading the file to the client machine [col 2, lines 1-8]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [col 2, lines 1-8]

Reha discloses downloading a file list but is silent regarding a list of cookie file sources. Hui Hsu discloses a list of cookie file sources [ID number of each web site in paragraphs 58 and 63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reha to include a list of cookie file sources as taught by Hui Hsu for the purpose of determining by a server which cookie(s) are appropriate to forward to a web site making a request [paragraph 62].

Claims 3, 18 and 24:

The combination of Reha and Hui Hsu discloses receiving updates of the downloaded list from the server on a periodic basis [paragraph 25, Hui Hsu]

Claims 6, 15, 21, 26 and 30:

The combination of Reha and Hui Hsu discloses preventing detected cookie files from being stored in the client machine [paragraph 51, Hui Hsu].

Claims 2, 8-15, 17 and 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Reha and Hui Hsu and further in view of US Pat No 6,023,723 to McCormick et al (hereafter McCormick).

Claims 2 and 17:

The combination of Reha and Hui and Hsu discloses the elements of claim 1 as noted above. Furthermore, Hui Hsu discloses (d) creating a first exception list including the identity of sources that are permitted to store cookie files in the machine [paragraph 58] and (e) creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine [paragraph 51] but fails to disclose modifying the downloaded list in accordance with the first and second exception lists. McCormick discloses modifying the downloaded list in accordance with the first and second exception lists [abstract, user's system is modified per the "not receive list" and the "to receive list"]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include modifying the downloaded list in accordance with the first and second exception lists for the purpose of filtering junk e-mails [abstract]. The skilled artisan would have been motivated to improve the invention of Reha and Hui Hsu per the above such that a user's time is saved by not having to review e-mails that he/she is not interested in.

Claims 7 and 22:

Reha discloses (c) receiving at the client machine, from a service provider, a master list of cookie file sources [col 2, lines 1-8] but fails to disclose (a) creating a first exception list including the identity of sources that are permitted to store cookie files in the client machine and (b) creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine. Hui Hsu discloses (a) creating a first exception list including the identity of sources that are permitted [paragraph 58] to store cookie files in the client machine and (b) creating a second exception list including the identity of sources that are not permitted [paragraph 62] to store cookie files in the client machine.

The combination of Reha and Hui Hsu discloses the elements of instant claim as noted above but fails to disclose modifying the master list in accordance with the first and second exception lists, wherein the composite list is the modified master list. McCormick discloses modifying the downloaded list in accordance with the first and second exception lists [abstract, user's system is modified per the "not receive list" and the "to receive list"]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include modifying the downloaded list in accordance with the first and second exception lists for the purpose of filtering junk e-mails [abstract]. The skilled artisan would have been motivated to improve the invention of Reha and Hui Hsu per the above such that a user's time is saved by not having to review e-mails that he/she is not interested in.

Claims 8, 13, 23 and 28:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, Hui Hsu discloses wherein the composite list is stored in the client machine independent of the first exception list, the second exception list and the received master list [paragraph 51].

Claims 9 and 24:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, Hui Hsu discloses receiving updates of the downloaded list from the server on a periodic basis [paragraph 25]

Claims 10, 14, 20, 25 and 29:

Art Unit: 2161

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, McCormick discloses removing stored files at the client machine from sources on the composite list [abstract].

Claims 11, 15, 21, 26 and 30:

The combination of Reha, Hui Hsu and McCormick discloses the elements of claim 7 as noted above. Furthermore, Hui Hsu discloses preventing detected cookie files from being stored in the client machine [paragraph 51].

Claims 12 and 27:

Reha discloses (a) receiving at the client machine, from the service provider, a master list of file sources [col 2, lines 1-8] but does not disclose downloading a file list but is silent regarding a list of cookie file sources. Hui Hsu discloses a list of cookie file sources [ID number of each web site in paragraphs 58 and 63]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Reha to include a list of cookie file sources as taught by Hui Hsu for the purpose of determining by a server which cookie(s) are appropriate to forward to a web site making a request [paragraph 62]. Furthermore, Hui Hsu discloses trusted [paragraph 51] and untrusted [paragraph 57] cookie file sources.

The combination of Reha and Hui Hsu discloses the elements of instant claim as noted above but fails to disclose (b) deleting cookie file sources from the master list that correspond to one or more file sources listed in the client machine (c) adding cookie file sources to the master list that correspond to one or more file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of file sources. McCormick discloses

Art Unit: 2161

(b) deleting cookie file sources from the master list that correspond to one or more file sources listed in the client machine (c) adding cookie file sources to the master list that correspond to one or more file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of file sources [abstract]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include (b) deleting cookie file sources from the master list that correspond to one or more file sources listed in the client machine (c) adding cookie file sources to the master list that correspond to one or more file sources listed in the client machine, wherein the composite list is the master list as modified by any additions and deletions of file sources for the purpose of filtering junk e-mails [abstract]. The skilled artisan would have been motivated to improve the invention of Reha and Hui Hsu per the above such that a user's time is saved by not having to review e-mails that he/she is not interested in.

Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Reha and Hui Hsu and further in view of US Pat No 5,864,848 to Horvitz et al (hereafter Horvitz).

Claims 4 and 19:

The combination of Reha and Hui Hsu discloses the elements of claim 1 as noted above but fails to disclose displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected. Horvitz discloses displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected [col 2, lines 17-32]. It would have been obvious to one of

Art Unit: 2161

ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected as taught by Horvitz for the purpose of informing a user of an incoming e-mail [col 2, lines 17-32].

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Reha and Hui Hsu and further in view of US Pat No 5,826,242 to Montulli.

Claim 5:

The combination of Reha and Hui Hsu discloses the elements of claim 1 as noted above but fails to disclose removing the detected cookie files from the client machine. Montulli discloses removing the detected cookie files from the client machine [col 8, lines 30-35]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reha and Hui Hsu to include removing the detected cookie files from the client machine as taught by Montulli for the purpose of deleting cookies that had expired [col 8, lines 30-35]. The skilled artisan would have been motivated to modify the combination of Reha and Hui Hsu per the above for the purpose of removing cookies which the client did not want to store on his/her computer.

Response to Arguments

Applicant's arguments filed 4/22/2005, have been considered but they are not fully persuasive.

Applicant Argues:

Applicant states in the first paragraph on page 7 "The comparison shows that key portions of Hsu relied upon by the Examiner, particularly, paragraphs [0062] and [0063] did not exist in Hsu's priority application. Accordingly, Hsu is not entitled to an earlier priority data for the disclosures in Hsu relied upon by the Examiner in the outstanding rejections. Therefore, Applicants' patent application has an earlier priority data than Hsu and thus all of the outstanding rejections which are based upon Hsu must be withdrawn.

Examiner Responds:

Examiner is not persuaded because applicant is in error. Examiner in above Office action does not reference paragraphs [0062] and [0063] as stated by applicant. Reference to above Office action will show that examiner references database 32 per Fig 1, paragraph 58 and paragraph 89. Above references are fully supported in the earlier filing, i.e., Continuation-in-part of application No. 09/580,365, filed May26, 2000. The only differences are that in application No. 09/580,365, database 32 is included in Figure 4, paragraph 58 is the first paragraph on page 16 paragraph 89 is the second paragraph on page 20.

Applicant Argues:

Applicant states in the second paragraph of page 2 "In sum, Montulli thus does not disclose or suggest any of the three steps in claims 1 and 16, each of which require a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine."

Examiner Responds:

Examiner is not persuaded. MPEP § 2106 requires that Office personnel give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). It is appropriate, therefore, to

Art Unit: 2161

consult the supporting disclosure provided by applicant for an interpretation of the phrase “list of cookie file sources” as included in the independent claims of instant application.

The abstract includes a watch list, a trustlist, a blacklist and a composite list.

Paragraph 8 includes one or more exception lists, a composite list

Paragraph 9 includes professional recommendations regarding a list of cookie file sources

Paragraph 10 includes a first exception list, a second exception list, a downloaded list created by a professional service provider, a separate composite list, updates of the downloaded list, modified downloaded list,

The multiplicity of lists is confusing. The scope of applicant’s invention is difficult to determine. As applicant has failed to provide a clear and precise definition of “list of cookie file sources” examiner will resort to a common dictionary¹ which defines list as a series of items of any kind no matter what the arrangement or purpose. The following disclosure by Montulli reads on above dictionary definition of a list:

Consider Montulli column 9, lines 19-25:

As previously described, when a client receives a set-cookie command in a header, the client system stores the cookie in some type of storage. In order not to place too much burden on client systems, each client system is expected to be able to store only a limited number of cookies. In one embodiment, the storage requirements for the client systems are:

- (1) 300 total cookies
- (2) 4 kilobytes per cookie; and
- (3) 20 cookies per server or domain (note that this rule treats completely specified hosts and domains which are different as separate entities, and each entity has a 20 cookies limitation).

Montulli per the above, inherently discloses a list of cookie file sources because multiple cookies from multiple sources are stored in a client’s system.

¹ Webster’s New World College Dictionary, Fourth Edition

Consider column 9, lines 53-63 of Montulli's disclosure:

When a client system that implements the present invention wishes to send an http request to a particular Web server, the client system first examines its cookie list to see if the cookie list contains any matching cookies that need to be sent to the particular Web server. Specifically, before the client sends an http request to a Web server, the client compares the URL of the requested Web document against all of the stored cookies. If any of the cookies in the cookie list matches the requested URL then information containing the name/value pairs of the matching cookies will be sent along with the HTTP request.

Montulli per the above, specifically discloses a list of cookies being stored at the client machine. Furthermore, Montulli discloses a client system first examines its cookie list to see if the cookie list contains any matching cookies and this disclosure by Montulli reads on the claim limitation "using the downloaded list to detect cookie files received at the client machine from sources on the downloaded list."

Consider Montulli's disclosure in column 10, lines 12-24:

Some clients access Web servers on the Internet through firewall systems that are designed to prevent unwanted Internet traffic from affecting a local area network coupled to the Internet. Firewall systems often implement "proxy servers" that filter traffic to and from the Internet. It is important that proxy servers not cache Set-cookie commands when caching HTTP information. Thus, if a proxy server receives a response that contains a Set-cookie header, the proxy server should immediately propagate the Set-cookie header to the client. Similarly, if a client system request contains a "Cookie: " header, the cookie header should be forwarded through a proxy even if a conditional "If-modified-since" request is being made.

The above disclosure by Montulli reads on the claim 1 limitation (a) receiving, at a server, a request from a subscriber to send a list of cookie file sources to the client machine; (b) downloading the list from the server to the machine.

Consider Montulli's disclosure in column 12, lines 55-62:

Art Unit: 2161

The browser software running on the client system stores the cookies describing the selected products within the client computer system (step 226). The stored cookies include an identification of the contents of a virtual shopping basket that contains the products selected by the consumer. In an embodiment of the present invention, the cookies are stored in a file located in a storage medium (such as a hard disk) of client computer system 140.

The above disclosure by Montulli reads on the claim 1 limitation (a) receiving, at a server, a request from a subscriber to send a list of cookie file sources to the client machine; (b) downloading the list from the server to the machine.

Consider Montulli's disclosure in column 13, lines 7-14:

After selecting a product, the customer may do additional shopping (e.g. buy a hat) from the same store or other stores (step 228). In this case, steps 212, 214, 215, 216, 218, 222, 224, and 226 (Fig. 5) need to be performed for the additional products. Each selection of a product in step 222 will result in the transmission of a cookie from the server to the client, which cookie identifies the selected product.

The above disclosure by Montulli reads on the claim 1 limitation (a) receiving, at a server, a request from a subscriber to send a list of cookie file sources to the client machine; (b) downloading the list from the server to the machine.

Applicant Argues:

Applicant states in the second paragraph of page 4 "To summarize, even though Hsu maintains a list of cookie file sources. Hsu also fails to disclose or suggest any of the three steps in claims 1 and 165, each of which require a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine. Hsu also does not disclose or suggest at least step © of claims 7 and 22 and step (a) of claims 12 and 27, both of which require receiving at a client machine, from a service provider, a master list of cookie file sources. Hsu thus suffers from the same deficiencies as highlighted above in Montulli.

Examiner Responds:

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Reference to above Office Action will show that Montulli discloses a downloaded list of cookie file sources as recited in step (c) of claims 7 and 22 and step (a) of claims 12 and 27. Furthermore, Montulli discloses the three steps of claims 1 and 16.

Applicant Argues:

Furthermore, the individual, user-driven cookie control processes described in Hsu and Montulli both suffer from one of the prior art deficiencies highlighted in the background of the present application.

Examiner Responds:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the background of the present application) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant Argues:

Applicant states in the second paragraph on page 5 "The downloaded list is not used to detect files received at the client machine from sources on the downloaded list. Instead, the downloaded list is used to determine whether or not to update the software program.

Examiner Responds:

Examiner is not persuaded. Examiner maintains that the downloaded list is used to detect files received at the client machine because the files are compared against each other in order to determine whether the selected file is the same version as the file stored on the client computer system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

6/29/2005


**MOHAMMAD ALI
PRIMARY EXAMINER**